

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. KENNEDY, III, MICHAEL J. TZIVANIS,
VIKTOR KELLER, WILLIAM M. RISEN, JR.,
MARK L. BINETTE, and JOHN L. NEALON

Appeal 2006-1969
Application 10/712,942

ON BRIEF

Before WALTZ, TIMM and JEFFREY T. SMITH, **Administrative Patent Judges.**

WALTZ, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 10 through 28, which are all of the claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a golf ball comprising a core, an inner cover layer disposed on the core having a Shore D hardness value of at least 60 and including at

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least one specified material, and an outer cover layer disposed about the inner cover layer having a Shore D hardness value of no more than 55, wherein the golf ball has a spin factor of at least about 5, a PGA compression of 100 or less, and a coefficient of restitution (COR) of at least 0.770 (Brief, pages 2-3).

Representative independent claim 15 is reproduced below:

15. A golf ball comprising:

an inner ball, the inner ball comprising a core and an inner cover layer disposed about the core, the inner ball having a coefficient of restitution of at least 0.780; and

an outer cover layer disposed about the inner ball, the outer cover layer having a Shore D hardness of no more than 55 as measured on the curved surface thereof;

wherein the golf ball exhibits a coefficient of restitution of at least 0.770 and a PGA compression of 100 or less.

The examiner has relied on the following references as evidence of unpatentability:

Isaac	3,989,568	Nov. 02, 1976
Nesbitt	4,431,193	Feb. 14, 1984
Sullivan et al. (Sullivan)	6,213,894	Apr. 10, 2001
Yabuki	6,359,066	Mar. 19, 2002

Claims 10-12, 14-18, 21-22, 25 and 26 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Nesbitt (Answer, page 3). Claims 13, 19, 20, 23, 24, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nesbitt in view of Isaac (*id.*). Claims 10-28 stand rejected under the judicially created doctrine of obviousness-type- double patenting as unpatentable over claims 1-42 of Sullivan (Answer, page 4).

Based on the totality of the record, including the records of related Appeal No. 2005-1119 (Application No. 10/074,665) and Appeal No. 2004-1184 (Application No. 10/074,849), we affirm all rejections on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

A. The Rejection for Obviousness-type Double Patenting

Appellants do not address the obviousness-type double patenting rejection of claims 10 through 28 in the Brief other than to state that "Applicants will file a Terminal Disclaimer once the other issues have been overcome" (Brief, page 4). Since appellants do not contest this rejection, we summarily affirm the examiner's rejection of claims 10-28 under the judicially created doctrine of

obviousness-type-double patenting as unpatentable over claims 1-42 of Sullivan.

B. The Rejections over Nesbitt alone

The examiner finds that Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer, where Nesbitt exemplifies inner cover layers made from Surlyn 1605 (an ionomer) with a Shore D hardness of 62 and outer cover layers made from Surlyn 1855 (an ionomer) with a Shore D hardness of 55 (Answer, page 3, citing Yabuki at col. 11 as evidence of the Shore D hardness values for Surlyn 1605 and 1855; see also page 5 of the Answer).¹ The examiner also finds that Nesbitt teaches that the coefficient of restitution (COR) of the core is 0.770 and the COR of the core and inner cover layer is 0.800 or more (Answer, page 3). From these findings, the examiner concludes that the claimed properties of spin factor, PGA compression, and COR would

¹See footnotes 3 and 4 on pages 4-5 of our decision in Appeal No. 2005-1119 for the well known equivalency of Surlyn 1605 and "hi-milan 1605," as well as Surlyn 1855 and "hi-milan 1855." We note that appellants do not contest or dispute any of the examiner's findings from Yabuki (see the Brief in its entirety).

have been inherent or obvious in view of Nesbitt teaching the same materials as claimed by appellants (*id.*).² We agree.

Appellants argue that Nesbitt does not disclose or claim the specific Shore D hardness of the cover layers, nor does Nesbitt limit the cover layers to materials having a specific Shore D hardness (Brief, page 5). Appellants are correct that Nesbitt does not disclose or claim any specific Shore D hardness for the inner or outer cover layers. However, appellants have not disputed the examiner's findings from Yabuki that the exemplified inner cover layer taught by Nesbitt (Surlyn 1605) has a Shore D hardness of 62, and the exemplified outer cover layer taught by Nesbitt (Surlyn 1855) has a Shore D hardness of 55, which is within the scope of claim 15 on appeal (which recites no value for the Shore D hardness of the inner cover layer and a Shore D hardness of "no more than 55" for the outer cover layer). Therefore appellants' argument is not persuasive since an example of Nesbitt falls within the scope of claim 15 on appeal. See *In re May*, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978).

²Since appellants do not argue any claim with specificity (see the Brief in its entirety), we limit our consideration to the broadest independent claim, i.e., claim 15. See 37 CFR § 41.37(c)(vii)(2004).

Appellants further argue that Nesbitt does not disclose or claim a PGA compression of 100 or less, a spin factor, or the COR (Brief, page 5). Appellants argue that the burden is on the examiner to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the prior art (*id.*).

Appellants' arguments are not persuasive. First, we note that claim 15 on appeal does not require a "spin factor" property.³ Second, the examiner finds, and appellants do not dispute, that the PGA compression for all golf balls is less than 100 or the golf balls are not suitable for play (Answer, page 7). Third, we agree with the examiner that the COR taught by Nesbitt is within the scope of the values recited in claim 15 on appeal for the "inner ball" ("at least 0.780" in claim 15 vs. 0.800 in Nesbitt, at col. 3, ll. 26-32; see the Answer, page 6). Furthermore, the examiner has presented technical reasoning that reasonably supports a determination that the COR of the final ball of Nesbitt falls within the claimed COR value of at least 0.770 (Answer, page 7).

³Even assuming the spin factor was recited in the claim under consideration, this property would have been inherent or obvious for the reasons stated on pages 6-8 of the decision in Appeal No. 2005-1119.

Appellants have not contested or disputed the examiner's reasoning.⁴ Contrary to appellants' arguments, we determine that the examiner has provided sufficient evidence to establish a reasonable belief that the properties of the Nesbitt golf ball would have inherently been the same as the claimed golf ball properties. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990); and *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

In an attempt to rebut the examiner's evidence, appellants argue that their specification includes example golf balls made using the materials disclosed in Nesbitt, and these golf balls do not meet the COR limitations of the claims (Brief, page 6, specifically citing Examples 3 and 4 and Tables 16-18, especially finished ball 5 in Table 17). However, as correctly noted by the examiner (Answer, pages 6-7), the finished ball 5 in Table 17 cannot be considered a golf ball within the scope of the Nesbitt disclosure since the intermediate ball COR of the tested ball of

⁴We also note the teachings of Nesbitt that the maximum COR should be attained for the intermediate ball (col. 1, ll. 57-60) and the COR of the final golf ball closely approaches or attains "that which provides the maximum initial velocity permitted" by the USGA (paragraph bridging cols. 1-2).

0.793 does not meet the requirement of Nesbitt of a COR of 0.800 or more for such an intermediate ball.

For the foregoing reasons, as well as those reasons set forth in the Answer, we determine that the examiner has established a reasonable belief that the products of claim 15 on appeal are the same or at least obvious over the disclosure of Nesbitt, which belief has not been adequately rebutted by appellants' arguments and evidence. Therefore we affirm the examiner's rejection of claims 10-12, 14-18, 21-22, 25 and 26 under section 102(b) or section 103(a) over Nesbitt.

C. The Rejection over Nesbitt in view of Isaac

The examiner applies Nesbitt as discussed above and in the Answer, but finds that Nesbitt fails to disclose that the outer cover layer may be made of polyurethane (Answer, page 3). Therefore the examiner applies Isaac for its teaching of polyurethane as a cover material for golf balls (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art to substitute the polyurethane cover of Isaac for the outer cover layer of the golf ball of Nesbitt to obtain a golf ball with "good click and feel" (*id.*). We agree.

polyurethane outer cover layer, and is solely directed to a single cover layer golf ball (Brief, page 7).⁵

This argument is not persuasive. The examiner has not applied Isaac for a teaching of a cover layer to replace the entire cover layer of Nesbitt. The examiner has applied Isaac for its teaching that the cover of a golf ball can be made from polyurethane to produce advantageous results, i.e., a "good click and feel" (Answer, page 3). Additionally, we note that Isaac discloses the advantages and disadvantages of the popular cover layer material "Surlyn," which is the same ionomer exemplified by Nesbitt (Isaac, col. 1, ll. 15-23; see Nesbitt, col. 2, ll. 30-48). Isaac goes on to teach the advantages of using polyurethane as a substitute for balata (the original golf ball cover) or Surlyn, e.g., its relatively low price, good cut resistance, and good click and feel (col. 1, ll. 24-31; see the Answer, page 9). Accordingly, we agree with the examiner that it would have been well within the ordinary skill in the golf ball art to replace the outer cover of Nesbitt with a polyurethane cover material to achieve the advantageous

⁵Appellants do not argue any particular claim with specificity (see the Brief, pages 7-8). Therefore we select claim 19 from the group of rejected claims and limit our consideration to this claim alone. See 37 CFR § 41.37(c)(vii) (2004).

results over the Surlyn ionomer outer cover of Nesbitt, as taught by Isaac.

For the foregoing reasons, as well as those set forth in the Answer, we determine that the examiner has established a prima facie case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of § 103(a). Therefore we affirm the examiner's rejection of claims 13, 19, 20, 23, 24, 27 and 28 under § 103(a) over Nesbitt in view of Isaac.

D. Summary

The rejection of claims 10-28 for obviousness-type double patenting over claims 1-42 of Sullivan is affirmed.

The rejection of claims 10-12, 14-18, 21-22, 25 and 26 under 35 U.S.C. § 102(b)/ § 103(a) over Nesbitt is affirmed. The rejection of claims 13, 19, 20, 23, 24, 27 and 28 under 35 U.S.C. § 103(a) over Nesbitt in view of Isaac is also affirmed.


The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

AFFIRMED

THOMAS A. WALTZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

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